

REMARKS

Rejection under 35 U.S.C. 112, First Paragraph

On page 3 of the Office Action, in paragraph 8, claims 1, 3-13, 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

In response, Applicants have amended the claims to resolve this issue. In this regard, Applicant has (1) amended claim 1 to (a) delete the recitation "provided that ... halogen substituent" from the end of the claim and (b) amend the recitation for Z so that it is just directed to C=O and (2) added claims corresponding to present claims except that the claim corresponding to claim 1 does (a) not include the recitation "provided that ... halogen substituent" from the end of the claim and (b) recite that Ra is a saturated or unsaturated lower or medium aliphatic hydrocarbon which has a halogen substituent.

Further, Applicant submits that the specification does not need to disclose specific examples of claimed compounds in order to provide an adequate written description. Rather, the specification only needs to show that Applicant was in possession of the claimed invention at the time the application was filed. In this regard, Applicant submits that the specification refers to Ra being a saturated or unsaturated lower or medium aliphatic hydrocarbon at, e.g., page 9, lines 12-13, with additional discussion of what is meant by unsaturated and lower or medium aliphatic hydrocarbon at page 11, lines 10-24, and the specification refers to 15-keto compounds (i.e., compounds where Z is C=O), e.g., at page 18, line 9 and in the Example at page 25, so one would consider that Applicant was in possession of the claimed invention at the time the application was filed. Indeed, Applicant submits that the compound in the Example at page 25 is

an example of a compound in which Z is C=O and Ra is a saturated or unsaturated lower or medium aliphatic hydrocarbon.

Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Anticipation Rejection over Ueno

On page 3 of the Office Action, in paragraph 10, claims 1, 3-13, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueno et al. (U.S. Patent No. 5,234,954).

In response, Applicants submit that the '954 patent discloses that 15-keto-PG is useful for the treatment of hyperlipemia. Obesity and hyperlipemia are different diseases and, therefore, an agent effective for treating hyperlipidemia is not necessarily effective for treating obesity, i.e. reducing the body weight. In Test Example 1 of the '954 patent, phospholipid, free cholesterol, total cholesterol and triglyceride in the blood of rat was significantly decreased by administering a 15-keto PG compound but almost no influence was observed in respect to the body weight (column 18, Tables 1 and 2 and lines 39-40). Accordingly, the '954 pat does not anticipate the instant claims. In contrast, the instant invention confirmed the effect of the compound to reduce the body weight in human.

Finally, Applicants note that in order to differentiate the instant invention more clearly from the '954 patent, the patient to be treated is limited to those "in need of reduction of body weight". This is supported by the working examples.

Thus, Applicants respectfully request reconsideration and withdrawal of this rejection.

Obviousness Rejection

On page 5 of the Office Action, in paragraph 12, claims 1, 3-13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueno et al. (U.S. Patent No. 5,234,954), as evidenced by Dietz (Pediatrics, Vol. 101, Issue 3 (Supplement), pages 518-525).

In response, Applicant submits that even if hyperlipidemia has been associated with obesity in the art, the disclosure of a method of treating hyperlipidemia does not teach, suggest, or otherwise render obvious a method of treating obesity. That is, if one wished to treat obesity, one would not have used a method of treating hyperlipidemia as in Ueno, because one would not have expected such a method to treat obesity.

According to Dietz, not only hyperlipidemia but also hypertension, abnormal glucose tolerance occur with increased frequency in obese people (abstract). The examiner alleged that treating hyperlipidemia in obese individuals would inherently treat obesity. If the examiner's theory is applied, drugs for the treatment of hypertension and abnormal glucose tolerance are also effective for the treatment of obesity. However, a person with hyperlipidemia is not necessarily a obese person. In addition, drug which is effective for the treatment of hypertension is not necessarily effective for the treatment of obesity.

Thus, Applicants respectfully request reconsideration and withdrawal of this rejection.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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